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TO
Examiner LubyFAX NO.
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Comments:

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Examiner Luby.

Please find enclosed a copy of Ex Parte Rex W. Beasley (Bd. Pat. App. 1997) which provides an analysis of the In re Stevens case relied upon in numbered paragraphs 5 and 7 of the final rejection. Applicants request the Examiner review Beasley, in particular the marked portions, prior to the scheduled interview.

Further, the Applicants wish to address the Examiner's rejection in numbered paragraph 3.

I look forward to our interview tomorrow at 2:00 pm (DC time) to discuss the current rejections in the above-identified application. Thank you.

Bill Meyers

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: 1997 WL 1948977 (Bd.Pat.App & Interf.)

*1 THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

Board of Patent Appeals and Interferences

Patent and Trademark Office (P.T.O.)

EX PARTE REX W. BEASLEY

Appeal No. 1997-1812

Application 08/055,382 [FN1]

NO DATE REFERENCE AVAILABLE FOR THIS DOCUMENT

Kelly, Bauersfeld & Lowry

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Before ABRAMS, STAAB and GONZALES

Administrative Patent Judges.

STAAB

Administrative Patent Judge.

ON BRIEF

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1, 3-5, 7, 8, 11-20, 23-27, 30-33, 35 and 36. [FN2] Claims 6, 9, 10, 21, 22, 28 and 29 have been allowed. Claim 34, the only other claim remaining in the application, has been indicated by the examiner as being allowable if rewritten in independent form to include all the limitations of the base claim from which it depends and any intervening claim. Claim 2 has been canceled.

Appellant's invention pertains to a turntable for installation into a building. The turntable comprises a plurality of modular pie-shaped panel units cooperatively assembled to define a rotatable floor surface of circular shape. Independent claim 1, a copy of which is found in an appendix to appellant's brief, is illustrative of the appealed subject matter.

The references of record relied upon by the examiner in support of rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103 are:

Coffey	1,772,858	Aug. 12, 1930
Chatard	3,941,146	Mar. 2, 1976
Funke	4,191,437	Mar. 4, 1980
Wertz	5,245,929	Sep. 21, 1993

The following rejections are before us for review:

a) claim 35, rejected under 35 U.S.C. § 112, first paragraph, as being based on a disclosure that does not comply with the enablement requirement found in that paragraph; [FN3]

b) claim 36, rejected under 35 U.S.C. § 112, fourth paragraph, "as being of

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improper dependent form for failing to further limit the subject matter of a previous claim" (final rejection [FN4], page 2);
 c) claims 1, 3, 5, 11, 16-18, 20, 23 and 30, rejected under 35 U.S.C. § 102(b), as being anticipated by Coffey;
 d) claims 4, 12, 14, 19, 24, 32 and 33, rejected under 35 U.S.C. § 103, as being unpatentable over Coffey;
 e) claims 7 and 8, rejected under 35 U.S.C. § 103, as being unpatentable over Coffey in view of Chatard;
 f) claims 13, 25-27 and 36, rejected under 35 U.S.C. § 103, as being unpatentable over Coffey in view of Funke; and
 g) claims 15 and 31, rejected under 35 U.S.C. § 103, as being unpatentable over Coffey in view of Wertz.

The § 112, 1st paragraph, rejection of claim 35

Claim 35 calls for means for interconnecting the pie-shaped panel units that "permit[] flex movement of said adjacent pair of panel units along said radial line of separation therebetween." The examiner contends (answer, page 5; emphasis in original) that "lines 28-34 on page 3 of the specification disclose 'the individual panel units are rigid yet flex along the lines of separation'.... It is unclear how ... a rigid panel unit can flex." The examiner further contends (answer, page 6) that

*2 [d]rawing figure 4 combined with the disclosure on page 9 infer that the beams 34 are fixed (nonmovable/nondetachable) in the groove of the wheel bracket. If adjacent beams 34 are fixed to each other, how can the panel unit flex? Appellant has not provide[d] adequate disclosure for this feature.

We will not sustain this rejection. Like appellant, we think the examiner has misconstrued the term "fixing" appearing on page 9, line 25, of the specification. Page 9, lines 22-27 of appellant's specification states that the wheel brackets are "for securely fixing the adjacent beams 34 with respect to each other, while permitting some relative flex between the connected units" (emphasis added). That is, the wheel brackets constitute a joint between the panels "for securely fixing" (i.e., capturing or holding) adjacent panel relative to one another, while permitting a limited amount of flex between the panel units along the radial lines of separation. The specification in effect instructs the skilled artisan to design the joint so that it is robust enough to hold the panel units together, yet supple enough to permit some flex at the joint line therebetween. The skilled artisan would have no trouble, in our view, in fabricating such a joint. In this regard, compliance with the first paragraph of § 112 is adjudged from the perspective of the person skilled in the pertinent art (In re Smith, 481 F.2d 910, 914, 178 USPQ 620, 624 (CCPA 1973)) and an inventor need not explain every detail since he is speaking to those skilled in the art (In re Howarth, 654 F.2d 103, 105, 210 USPQ 689, 691 (CCPA 1981)).

The § 112, 4th paragraph, rejection of claim 36

The examiner contends (final rejection, page 2) that claim 36 merely restates paragraph 2 of claim 25, and does not further limit the subject matter of that claim.

In that the dependency of claim 36 has been changed from claim 25 to claim 35 by the amendment filed subsequent to the final rejection, and in that claim 36 does not restate any limitations found in claim 35 from which it now depends, the reason for the examiner's § 112, fourth paragraph, rejection of claim 36 no longer exists. Accordingly, this rejection will not be sustained.

The § 102 rejection based on Coffey

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For a reference to anticipate a claim, each and every element of the rejected claim must be found either expressly described or under the principles of inherency in the applied reference. See, inter alia, RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPO 385, 388 (Fed. Cir. 1984). It follows that the absence from the reference of any element of the claim negates anticipation of that claim by the reference. Kloster Speedsteel AB v. Crucible, Inc., 793 F.2d 1565, 1571, 230 USPO 81, 84 (Fed. Cir. 1986), cert. denied, 479 U.S. 1034 (1987).

Independent claim 1 is directed to a turntable comprising a plurality of modular generally pie-shaped panel units adapted for assembly to cooperatively define a rotatable floor of generally circular shape, wherein the panel units are separated from adjacent panel units along radial lines of separation, and means for interconnecting each adjacent pair of panel units along the radial line of separation therebetween, said means comprising at least one wheel unit including a wheel bracket connected to the adjacent pair of panel units. Claim 1 further sets forth that the adjacent pair of panel units is incapable of disassembly when the wheel unit is connected thereto. Independent claim 18 and 30 contain similar limitations.

*3 Coffey pertains to a turntable comprising a skeletal framework of beams 14-17 to which a plurality of generally pie-shaped plates 19 are secured. Coffey describes the construction of the framework and pie-shaped plates as follows:

The rotatable turn-table is composed of a circular channel-beam 14 at the margin of the table; radial I-beams 15 and 16 having their outer ends rigidly secured to the circular beam; transverse beams 17 fixedly secured to the I-beams by angle-plates 19, and a series of metal plates 18 extending over and removably bolted to said beams. Said plates are arranged in annular series with their meeting edges over the beams 15, 16. [Page 1, lines 47-57.] As is apparent from Coffey's drawing figures, when assembled the plates 19 cooperatively define a floor of generally circular shape.

Coffey also discloses a plurality of wheel units mounted at the periphery of the turntable. Coffey describes the relationship between the wheel units and turntable as follows:

The margin of the table is supported by a series of pairs of rollers 21 in tandem which are adapted to run on a circular rail 22. Each pair of rollers is journaled in a bracket 23. The brackets 23 extend circumferentially under the radial beams 15, 16 in such a manner that said beams bear on the brackets respectively. Each bracket 23 is recessed, as at 24, to receive the lower flange of one of the radial beams, and is provided with lugs 25 between which said flange is confined. Each bracket 23, below the beam flange, is provided with a central abutment 26, on which the lower face of said flange bears. This construction forms a connection between the bracket and the beam which permits the bracket to slightly tilt vertically, so that the load will be equalized on both rollers of a pair, and will also permit the rollers to accommodate themselves to any slight irregularity in the rail 22. [Page 1, lines 58-79.]

In rejecting claim 1 as being anticipated by Coffey, it is not clear which element(s) of Coffey the examiner considers as corresponding to the claimed "pie-shaped panel units." For example, at several places [FN5] the examiner refers to plates 18 as panel units, while at other places the examiner appears to refer to Coffey's plates 18 and beams members 15, 16 as panel units [FN6]. In either case the examiner's rejection is not sustainable.

If Coffey's plates 18 alone are considered to correspond to the claimed panel units, then we simply do not agree with the examiner that "[a]s the panel units 18 are secured to the beams 15, 16 which in turn are confined between lugs 25 of wheel unit 21, 23, this arrangement renders the adjacent panel unit (15, 16, 18) [sic, 18?] incapable of disassembly when the wheel unit is connected thereto" (final rejection, page 5). As is made clear by the above quoted portions of Coffey's specification, and as aptly pointed out by appellant, the plates 18 extend over and are removably bolted to the beams of the skeletal framework of beams 14-17 (Coffey, page 1, lines 47-55), while the wheel units are secured to the lower flanges of the

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radial beams of the framework (Coffey, page 1, lines 66-72). We can think of no circumstance where one would consider Coffey's structure as rendering the plates incapable of being disassembled from the framework when the wheel units are connected thereto, as called for in each of independent claims 1, 18 and 30.

*4 Alternatively, if the examiner intends to read the claimed panel units on Coffey's plates 18 and beams 15, 16 collectively, the rejection is fundamentally flawed for several reasons. First, claims 1, 18 and 30 require the panel units to be "pie-shaped," which plates 18 and beams 15, 16, taken together, clearly are not. Second, claims 1, 18 and 30 require the panel units to be disposed between an adjacent pair of panel units, which plates 18 and beams 15, 16, taken together, clearly are not. Third, claims 1, 18 and 30 require the panel units to be separated from adjacent panel units along radial lines of separation, which plates 18 and beams 15, 16, taken together, clearly are not. For at least these reasons, the rejection of claims 1, 18 and 30 as being anticipated by Coffey based on this alternative interpretation is not well taken.

In light of the foregoing, we will not sustain the § 102 rejection of claims 1, 18 and 30 as being anticipated by Coffey. Likewise, we will not sustain the § 102 rejection of claims 3, 5, 11, 16 and 17 that depend from claim 1, or the § 102 rejection of claims 20 and 23 that depend from claim 18.

The § 103 rejection based on Coffey

The examiner acknowledges that Coffey does not disclose means for elevationally adjusting the support wheels (claims 4 and 19), means for elevationally adjusting the wheel track (claims 12 and 24), and means on the center bearing for elevationally adjusting the orientation of the assembled panel units (claim 14). However, the examiner considers (final rejection, page 3) that "these means are just obvious design choices, since it has been held to be within the general skill of a worker in the art to make structural members adjustable as a matter of obvious engineering design choice." The examiner also tacitly acknowledges that Coffey does not disclose the panel unit construction called for in claims 32 and 33. Nevertheless, the examiner considers (final rejection, page 3) that as to these differences, the beam 15 or 16 of Coffey is "functionally equivalent" to the claimed construction.

With respect to the subject matter of claims 4, 12, 14, and 19, the examiner's contention that the claimed adjustment means are "just obvious design choices" is without foundation in the absence of evidence supporting such contention. We note that the means in question are for the express purpose of fine tuning the turntable relative to its supporting structure. See, for example, page 10, lines 2-6, and page 11, line 36 through page 12, line 5, of appellant's specification. Thus, they are not merely a matter of obvious design choice solving no stated problem. Compare, In re Kuhle, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975). The Stevens case [FN7] cited on page 3 of the final rejection and again on page 5 of the answer in support the examiner's position is noted. In Stevens, the examiner cited references which taught both the basic concept of adjustability in the same art area as the claimed device, and the specific joints being claimed. Thus, in Stevens, the examiner provided sufficient evidence from which to conclude that the claimed subject matter would have been obvious. Such is clearly not the case here.

*5 As to claims 32 and 33, the examiner has cited no evidence to establish that the construction of Coffey is the "functional equivalent," whatever that may be, of the claimed subject matter. In any event, the mere existence of functional and mechanical equivalence does not establish obviousness. In other words, components which are functionally equivalent to each other are not necessarily obvious in view of one another. In re Scott, 323 F.2d 1016, 1019-20, 139 USPQ 297, 299 (CCPA 1963).

In the present case, the examiner has failed to indicate any teaching in Coffey or any prior knowledge generally available to one of ordinary skill in the art that would have led an ordinarily skilled artisan to equip Coffey's turntable with the

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claimed adjusting means (claims 4, 12, 14, 19 and 24) or panel unit construction (claims 32 and 33). For this reason alone, the § 103 rejection of claims 4, 12, 14, 19, 24, 32 and 33 must fail for lack of a sufficient factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPO 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

Furthermore, even if we were to agree with the examiner that the subject matter of claims 4, 12, 14, 19, 24, 32 and 33 would have been obvious, the incorporation of same into the turntable of Coffey would not cure the basic deficiencies of the Coffey device discussed above in our treatment of the § 102 rejection of independent claim 1, from which claims 4, 12, 14, 32 and 33 depend, and independent claim 18, from which claims 19 and 24 depend.

For these reasons, we will not sustain the standing § 103 rejection of claims 4, 12, 14, 19, 24, 32 and 33.

The § 103 rejections based on Coffey and Other Prior Art

Claims 7 and 8, rejected as being unpatentable over Coffey in view of Chatard, depend from claim 1 and further define the interconnection means for connecting adjacent panel units along the radial lines of separation. The examiner relies on Coffey for a teaching of the interconnection means called for in these dependent claims, and concludes that the claimed subject matter as a whole would have been obvious in view of the combined teachings of Coffey and Chatard. Even if we were to agree with the examiner that Chatard teaches the interconnection means of claims 7 and 8, and further agree that it would have been obvious to provide such interconnection means in Coffey, Chatard does not render obvious what we have found to be lacking in Coffey in our treatment of the standing § 102 rejection of claim 1. Accordingly, the § 103 rejection of claims 7 and 8 will not be sustained.

Claims 13 and 25-27 have been rejected under 35 U.S.C. § 103 as being unpatentable over Coffey in view of Funke. Claim 13 depends from claim 1 and further sets forth that the turntable of claim 1 includes means for structurally connecting the wheel track with the center bearing means. Independent claim 25 contains all the limitations of claim 1 regarding the panel units, radial lines of separation, means for interconnecting, and incapability of disassembly of the panel units when the wheel units are connected thereto. In addition, claim 25 contains all the limitations of claim 13 regarding the means for structurally connecting the wheel track with the center bearing means. In rejecting these claims, the examiner cited Funke for a teaching of providing means for connecting a wheel track 12b with a center bearing means 14a, and concluded that it would have been obvious to connect the wheel track of Coffey to the center bearing means thereof. Because Funke does not make up for the deficiencies of Coffey with respect to the basic turntable limitations found in claims 1 and 25, even if we were to agree with the examiner that it would have been obvious to modify Coffey in the manner proposed, the subject matter of claims 13 and 25-27 would not result. It follows that we will not sustain the standing § 103 rejection of these claims.

*6 Dependent claim 36 has also been rejected under 35 U.S.C. § 103 as being unpatentable over Coffey in view of Funke. However, it appears that this rejection is maintained by the examiner in this appeal based on the mistaken belief that claim 36 depends from 25, as it did at the time of the final rejection, rather than claim 35, as it does now. [FN8] Because claim 36 now depends for claim 35, it requires, inter alia, interconnecting means for each adjacent pair of panel units permitting flex movement thereof along the radial lines of separation therebetween, and wheel units connected to each adjacent pairs of panel units along the radial lines of separation. The examiner has not explained how the combined teachings of Coffey and Funke render obvious this subject matter; nor is it apparent to us how this subject matter would have been obvious to one of ordinary skill in the art in light of the teachings of the applied references. Accordingly, we cannot sustain the examiner's § 103 rejection of claim 36 based on Coffey in view of Funke.

Claims 15 and 31 stand rejected under 35 U.S.C. § 103 as being unpatentable over

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Coffey in view of Wertz. Each of these claims calls for seismic tie-down means disposed below the floor surface of the turntable for preventing substantial vertical upward displacement of the assembled panel units at the peripheral edge of the floor surface. The examiner cited Wertz for a teaching of "providing a turntable structure with means (44, 46) which is capable of functioning as seismic tie-down means to prevent substantial vertical displacement and/or stabilize the panel units at the peripheral edge thereof" (final rejection, pages 4-5). The examiner then concluded that

it would have been obvious to one skilled in the art to provide Coffey's turntable structure with a stabilize [sic, stabilization] means that is capable of functioning as a seismic tie-down means as taught by Wertz et al. to prevent substantial vertical displacement and/or stabilize the panel unit at the peripheral edge thereof. [Final rejection, page 5.]

Implicit in the above is the examiner's conclusion that the modified Coffey device would correspond to the subject matter of claims 15 and 31.

While we appreciate that the guide members 44 and circuitous channel 46 of Wertz provide a measure of lateral stability to the annular rotatable frame 12 (column 4, lines 22-27), claims 15 and 31 expressly require seismic tie-down means for preventing substantial vertical upward displacement of the turntable. Because the examiner has not explained how elements 44 and 46 of Wertz prevent vertical upward displacement of the frame 12, and because we are not apprised by the examiner of any other structure in either of the applied references that teaches seismic tie-down means that functions to prevent vertical upward displacement of the turntable at its peripheral edge as called for in the claims, the standing § 103 rejection of claims 15 and 31 cannot be sustained.

Summary

*7 Each of the examiner's rejections is reversed.

The decision of the examiner is reversed.

REVERSED

BOARD OF PATENT APPEALS AND INTERFERENCES

NEAL E. ABRAMS

Administrative Patent Judge

LAWRENCE J. STAAB

Administrative Patent Judge

JOHN F. GONZALES

Administrative Patent Judge

FN1. Application for patent filed May 3, 1993.

FN2. An amendment (Paper No. 19) filed subsequent to the final rejection has been entered. See the advisory letter mailed July 3, 1996 (Paper No. 20).

FN3. This is the only rejection of independent claim 35, notwithstanding that claim 36, which now depends from claim 35, continues to be rejected under 35 U.S.C. § 103 (see rejection (f) infra).

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FN4. All r ference to "final r jection" in this opinion denot the final rejection mailed January 23, 1996 (Paper No. 14).

FN5. See, for example, final rejection, page 2 ("Note pie-shaped panel units (18) ..." and final rejection, page 5 ("As the panel units 18 are secured to the beams 15, 16 ...").

FN6. See, for example, final rejection, page 5 ("The added limitation in claim 1 is broad enough to read on the securement between the panel units (18, 15, 16) and the wheel unit (21, 23) ..." and "this arrangement renders the adjacent panel units (15, 16, 18) incapable of disassembly ...").

FN7. That is, In re Stevens, 212 F.2d 197, 101 USPO 284 (CCPA 1954)

FN8. The dependency of claim 36 was changed from claim 25 to claim 35 in the amendment filed subsequent to the final rejection.

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